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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,791	09/19/2001	Mahiro Fujita	2185-0557P	8860

2292 7590 10/11/2002

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EXAMINER

AHMAH, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 10/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Application No.
09/889,791

Applicant(s)
Fujita et al.

Examiner
Nasser Ahmad

Art Unit
1772



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 16, and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-11, drawn to a laminate, classified in class 428, subclass 40.1.
- II. Claims 12-15, drawn to a resins composition, classified in class 521, subclass 50.

2. III. Claims 16-17, drawn to an article, classified in class 428, subclass 343.

3. Claims 16-17 link(s) inventions group I and group II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 16-17. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

4. Inventions group I and group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the resin composition comprises an epoxy resin and/or a modified silicone resin and is deemed to be distinct from the laminate of group I.

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Mr. John W. Bailey on September 3, 2002 a provisional election was made with traverse to prosecute the invention of group I, claims 1-11 and group III, claims 16-17. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-15 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

8. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Akada (5,304,418).

Akada relates to a laminate comprising a substrate (1), a radiation-curable pressure sensitive adhesive (PSA) layer (2), and an adhesive layer (3), which are laminated sequentially (abstract and figure - 1). The substrate can be plastic (col. 2, lines 54-60). The PSA loses adhesive power when exposed to radiation (col. 3, lines 7-9). The adhesive (3) can be thermosetting (col. 4, lines 43-46). The laminate can be formed into an article when bonded to chips and allows for reusing the laminate.

The intended use phrase “capable of” has not been given any patentable weight as it is not directed to a positive limitation but only requires its ability to do so.

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10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-11 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aizawa (5,609,954) in view of Akada.

Aizawa relates to a strippable PSA laminate comprising a substrate (col. 4, lines 46-50) and a PSA layer that loose its adhesively upon exposure to energy (abstract). The PSA can include ^aforming agents and additive such as crosslinkers (col. 3, lines 26-65). The ^aforming agent can include heat-expandable particles (col. 3, lines 66-67). However, Aizawa fails to teach the presence of an adhesive layer over the PSA layer. Akada, as discussed above, teaches the advantage of providing an adhesive layer over the PSA layer for fixing the separated chips to an adherand while keeping well-balanced adhesion and release properties (col. 3, lines 11-14). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Akada's teaching of using an adhesive layer over the PSA layer in the invention of Aizawa.

Further, with regard to claim 9, the presence of additional PSA layer and substrate on the other side of adhesive layer would have been obvious based on duplication of parts.


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 703-308-4424. The examiner can normally be reached on Monday-Thursday from 7:30 am to 5 pm, and on alternate Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

N. Ahmad/mn
October 10, 2002


NASSER AHMAD
PRIMARY EXAMINER